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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/731,968	12/06/2000	Yorihiko Sakai	21778.04800	1405

7590 07/11/2003

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EXAMINER

HO, THOMAS Y

ART UNIT PAPER NUMBER

3677

DATE MAILED: 07/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/731,968

Applicant(s)

SAKAI ET AL.

Examin r

Thomas Y Ho

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Specification

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because it exceeds the 150 word limit.

Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(I) Claims 1-6, 8-10, 12-14, 17-19, 20, 22, and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Shiota USPN6337712.

As to claims 1-6, 8-10, 12-14, 17-19, 20, 22, and 25, Shiota discloses:

- A server apparatus 6 connected to a network, for storing image data supplied via the above network; a terminal 15 used by the user to transmit said image data to said

server apparatus via said network and read said image data specified according to external operations from said server apparatus via said network (col.2, ln.32-41); said information storage system wherein: said server apparatus has storing means for storing said image data supplied via said network in association with specific identification information (col.3, ln.28-49), reading means for reading said image data corresponding to the above identification information from said storing means based on a reading request transmitted from said terminal via said network and said identification information, and transmitting means for transmitting said image data read from said storing means by said reading means to said terminal according to said reading request via said network (col.6, ln.34-38).

- Said storing means of said server apparatus 6 stores ordering data (col.6, ln.30-38), which is supplied together with said image data from said terminal via said network and created by said external operations by said user (col.6, ln.39-47) on the above user's desired utilization contents, in association with said identification information as a utilization history; said reading means reads said user's utilization contents corresponding to the above identification information from said utilization history stored in said storing means based on said reading request given from said terminal 15 via said network and said identification information; said transmitting means transmits said user's utilization contents read from said utilization history of said storing means by said reading means to said terminal on the above network according to said reading request via said network (col.7, ln.45-58).

- Said server apparatus 6 creates customer data based on said ordering data given from said terminal 15 and performs customer control based on the above customer data.
- Said terminal 15 includes printing means 9 for printing an image based on said image data read from said server apparatus according to said external operations via said network.
- Said terminal 15 includes recording means (col.6, ln.65-67; col.7, ln.1-22) for recording in a recording medium, said image data read from said server apparatus 6 according to said external operations via said network (col.7, ln.45-58).
- Said server apparatus 6 (Fig.3, top right) includes billing processing means for calculating a fee based on said ordering data and performing predetermined billing processing according to the above calculation result. All of the terminals 15 have are coin-operated, and the server 6 also has a coin-operated terminal directly attached for billing.
- Storing means for storing image data supplied from a terminal 15 via a network in association with specific identification information (col.3, ln.40-48); reading means (col.6, ln.65-67; col.7, ln.1-22) for reading said image data corresponding to the above identification information from said storing means based on a reading request given by the user from said terminal via said network and said identification information; transmitting means for transmitting said image data read from said storing means by said reading means to said terminal on the above network corresponding to said reading request via said network.

- Said storing means stores said user's utilization contents of the above image data during transmission operation on said terminal 15 which is supplied together with said image data from said terminal via said network (col.7, ln.45-58), in association with said identification information as a utilization history; said reading means reads said user's utilization contents corresponding to the above identification information from said utilization history stored in said storing means based on said reading request given from said terminal via said network and said identification information; said transmitting means transmits said user's utilization contents read from said utilization history of said storing means by said reading means to said terminal on the above network according to said reading request via said network.
- Said user's utilization contents includes at least one of personal information of said user, preference information and billing information (col.3, ln.29-49). The possessor code representing the possessor of the digital camera is personal information.
- Said transmitting means transmits via said network, said image data read by said reading means from said storing means to said terminal specified by said user through said reading request given via said network.
- A first step of storing image data supplied from a terminal 15 via a network in association with specific identification information (col.7, ln.1-10; col.3, ln.28-48); a second step of reading said image data (col.3, ln.1-9; col.7, ln.1-20) corresponding to the above identification information based on a reading request given by the user from said terminal via said network and said identification information; a third step of

transmitting said read image data to said terminal on the above network according to said reading request via said network (col.7, ln.45-58).

- In said first step, said user's utilization contents of the above image data during a transmission operation on the above terminal 15 supplied together with said image data from said terminal via said network are stored in association with said identification information as a utilization history (col.3, ln.28-48); in said second step, said user's utilization contents corresponding to the above identification information are read from said stored utilization history based on said reading request given from said terminal via said network and said identification information; in said third step, said user's utilization contents read from said utilization history are transmitted to said terminal on the above network according to said reading request via said network (col.7, ln.44-58).
- In said third step, said read image data is transmitted via said network to said terminal 15 specified by said user by said reading request given via said network (col.7, ln.44-58).
- Including a fourth step of calculating a fee based on said user's utilization contents and performing predetermined billing processing according to the above calculation result. All of the coin-operated terminals 15 perform billing operations.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(II) Claims 11 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiota USPN6337712 in view of Barraclough USPN6301607.

As to claims 11 and 21, Barraclough discloses the following not disclosed by Shiota:

- A server apparatus and information control method as disclosed in paragraph (I) above.
- Said personal information of said user includes at least one of said user's name, address, phone number and e-mail address (col.2, ln.61-67; col.3, ln.1-5).

Barraclough discloses the imbedding of personal information, such as a user's email address into an image to provide an easy way for return communications. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the personal information, specifically the possessor code, disclosed by Shiota, to have an email address imbedded, as taught by Barraclough, for ease of return communications.

(III) Claims 7, 15-16, and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiota USPN6337712 in view of Wang USPN6058428.

As to claims 7, 15-16, and 23-24, Shiota discloses:

- A server apparatus and information control method as disclosed in paragraph (I) above.
- Said server apparatus 6 stores image data, reads said image data from said storing means based on a reading request transmitted from said terminal 15 via said network and transmits said combined image data read from said storing means by said reading means to said terminal according to said reading request via said network.

- Said reading means reads said image data from said storing means according to said reading request; said transmitting means transmits said image data read from said storing means by said reading means to said terminal 15 according to said reading request.

Wang discloses the following not disclosed by Shiota:

- Not only image data, but also combined image data to combine an image based on said image data.
- Combined image data.

Wang discloses combined image data (otherwise known as an album) to show multiple pages with multiple pictures on a page (col.4, ln.40-45). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the image data disclosed by Shiota to be combined image data, as taught by Wang, to show multiple pages with multiple pictures on a page.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

USPN5327265 to McDonald discloses modem accessible image database system for on-demand printing.

USPN5553281 to Brown discloses a method for computer-assisted media processing.

USPN5706097 to Schelling discloses an index print with a digital recording medium.

USPN5974401 to Enomoto discloses a digital print order and delivery method and system.

USPN6011547 to Shiota discloses a method and apparatus for reproducing image from data obtained by a digital camera used therefor.

USPN6017157 to Garfinkle discloses a method of processing digital images and distributing visual prints.

USPN6133985 to Garfinkle discloses a method of processing digital images and distributing visual prints.

USPN6154295 to Fredlund discloses a system and method for selecting photographic images.

USPN6222646 to Maurinus discloses an electronic photography system.

USPN6324521 to Shiota disclose a network photograph service system.

USPN6353848 to Morris discloses a method and system allowing a client computer to access a portable digital image capture unit.

USPN6388732 to Williams discloses a method and apparatus for producing digital photographic prints.

USPN6535228 to Bandaru discloses a method and system for sharing images.

USPN6571271 to Savitzky discloses a networked appliance for recording, storing, and serving digital images.

USPN6583799 to Manolis discloses image uploading.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas Y Ho whose telephone number is (703)305-4556. The examiner can normally be reached on M-F 10:00AM-6:00PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J Swann can be reached on (703)306-4115. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9326 for regular communications and (703)872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)306-1113.

TYH
July 2, 2003



WILLIAM MILLER
PRIMARY